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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/524,371	02/10/2005	Richard Ronald Baynham	265330US6XPCT	4850

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EXAMINER	
HOOK, JAMES F	

ART UNIT	PAPER NUMBER
3754	

NOTIFICATION DATE	DELIVERY MODE
06/07/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/524,371	BAYNHAM ET AL.	
	Examiner	Art Unit	
	James F. Hook	3754	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *10 February 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *9-22* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *9-22* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *2/10/05*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

It is noted that the claims have been renumbered by hand. It is not clear due to the lack of initials who has changed the numbering and for what reason, but to insure the examiner and applicant are talking about the same claim numbers, the claims of the amendment of February 10, 2005 listed in the amendment as claims 11-24 have been renumbered to be 9-22. A copy of this can be seen in PAIR. The examiner will treat dependency based upon the originally filed numbers, therefore if a claim were dependent upon claim 11, the examiner will treat such as being dependent upon claim 9 now, and so on.

Specification

The use of the trademark PROGUARD CRB has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 15-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The use of the trademark PROGUARD CRB in the claims is indefinite where the scope of the claim cannot be determined since a trademark identifies a brand and not a product, where the brand could change. As set forth above the trademark should be capitalized in the specification and replaced in the claims by generic terminology. The speed up prosecution the examiner will treat the trademark as the equivalent of the generic description of the material used for the layer for purposes of examination.

Claims 9-17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. The wording of claim 9 is considered indefinite where the scope of the claim is not clear with regards to whether curable resin layer contains both ceramic filler and chopped carbon fiber, or whether such is in an alternative material to be used in place of the ceramic filler, where the specification discusses that the carbon fibers are optional, therefore it is believed that it is possible that the chopped carbon fibers are an option to the use of ceramic filler but such is not clear based upon the manner in which the claim is worded, and therefore the claim is considered indefinite as well as all the claims that depend therefrom.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Calderoni (WO 02/48501).

Claims 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Boyd (GB 2,282,615).

Claims 18-21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Thornton (WO 02/02904).

Claims 9-19 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hwang. The patent to Hwang discloses the recited the recited prefabricated tubular body 2 for use downhole comprising integral centralizer formations 4 formed as projections molded to the tubular body by using heat and pressure to attach them to the tubular where such are made of curable resins such as thermoplastics, where such can be provided with ceramic particulate filler material, in addition thereto fillers including antistatic agents can be provided, where carbon black fibers are fillers used to provide antistatic properties, the limitations of claim 10 appear only to recite method steps which would not change the final product materially of providing a projection that is heat and pressure molded of curing resin onto a pipe, the same is true of claim 11 which merely discloses the apparatus, specifically the mold, that is used to form the projections, both claim 10 and

11 hold no patentable weight on an article claim when such are not materially changing the final product, after forming the projections on the pipe the pipe can be coated with a polyester film which is a resin, the material used to make up the projections is considered in terms of generic terminology to be PROGUARD CRB, the tubular core is placed within other objects by sliding and therefore is capable of permitting rotation as well, and where the projections are formed as ribbing or stand off projections. The patent to Hwang discloses all of the recited material, however, without a clear understanding of whether carbon black is actually required in the material as such is considered indefinite above, if such were considered to be a requirement of the material recited in claim 9, then Hwang discloses the use of antistatic fillers and it is considered old and well known in the art that carbon black fibers are used as antistatic fillers in pipes, therefore it would have been obvious to modify the material in Hwang that discloses antistatic fillers to specifically use a known filler such as carbon black fibers to achieve antistatic properties as such would only require routine skill and knowledge in the art to select an appropriate material for it's specific use. As set forth above, that the material recited by the trademark name PROGUARD CRB in generic terms is the same material set forth in claim 9 and is therefore covered by the material used in Hwang as set forth above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hwang in view of Calderoni (WO 02/48501). The patent to Hwang discloses all of the recited structure including using heat and pressure to attach the projections to the pipe but fails to disclose the use of a mold to do so and the method of using the mold to attach the projections. The reference to Calderoni discloses that it is old and well known in the art to use a mold to attach projections of heat hardening plastic materials, such as thermoplastics, to the outside of a pipe and the method of doing so. It would have been obvious to one skilled in the art to modify the heat and pressure method of attaching the projections set forth in Hwang by using a method utilizing a mold to attach the projections as suggested by Calderoni where such would insure proper placement and shape of the projections thereby preventing poorly placed projections which could prematurely fail thereby saving money in replacement costs.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The references to Anderson, Schmidt, Garrett, Jarvis, Yoshino (699 and 204), Goodman, and Wellman disclosing state of the art pipes with projections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to James F. Hook whose telephone number is (571) 272-

4903. The examiner can normally be reached on Monday to Wednesday, work at home Thursdays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (571) 272-4720. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

James F. Hook
Primary Examiner
Art Unit 3754

JFH